

### **REMARKS**

Applicant respectfully requests reconsideration and allowance of the subject application. Claim 1 is amended. New claims 24-27 are added. Claims 1-27 are pending in this application.

The new formal drawings and the amendments to the specification address concerns noted in the Office Action, correct minor informalities noted during review and/or bring the drawing and specification into mutual conformance. The amendments to the claims address minor informalities noted during review and/or address concerns with respect to formal issues noted in the Office Action, however, these amendments are not intended to alter the scope of the claims.

### **35 U.S.C. § 112, SECOND PARAGRAPH**

Claims 1-6 stand rejected under 35 U.S.C. §112, second paragraph. Applicant traverses and respectfully requests reconsideration.

The Office Action states (p. 2) that the claim language is indefinite as to the plurality of annotations and the plurality of media streams, and then apparently seeks to read recitations from the specification into the claims. Such an interpretation improperly "reads into" the claims limitations from the specification, as explained below with reference to MPEP 2111.01, entitled "Plain Meaning". This MPEP section states that "THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS THEY ARE DEFINED IN THE SPECIFICATION", and further states that:

While the meaning of claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as

broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

However, in the spirit of cooperation and in order to advance the prosecution of the application, Applicant has amended claim 1 to address the concerns noted in the Office Action. This amendment is not intended to alter the scope of the claims.

The Office Action indicates (p. 3) that the meaning of "time-compressed" in claim 3 is not clear and proposes an interpretation of this terminology that is at odds and repugnant to the ordinary meaning of these terms. Applicant notes that such is improper, as is explained below in more detail with reference to MPEP §608.01(o), entitled "Basis for Claim Terminology".

This MPEP section states that "The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term."

A copy of page 302 from Webster's Encyclopedic Unabridged Dictionary of the English Language (Random House Company, New York, New York, copyright 1989) is enclosed to clarify the meaning of the term compressed as "pressed into less space; condensed" or "pressed together". When the term "compressed" modifies the term "time", "time" is "compressed", i.e., more action

occurs in less time. The interpretation proposed in the Office Action is inapposite and inappropriate.

Additionally, the language employed in claim 3 is definite and clear. Objective evidence for such may be found, among other places, at the USPTO web site. Applicant finds that 2126 patents can be found that include the phrase "time compressed", 594 patents include the phrase "time-compressed" and 335 patents include the phrase "time compressed" in the claims. As such, this phrase cannot possibly be indefinite. For at least these reasons, the rejection of claims 1-6 as being indefinite should be withdrawn, and claims 1-6 should be allowed.

### 35 U.S.C. § 101

Claims 10-12 are stated in the Office Action (p. 3) to stand rejected under 35 U.S.C. §101. Applicant respectfully traverses and requests reconsideration.

The Office Action states that these claims are directed to non functional descriptive data stored on a medium, but provides no authority for the position taken.

Applicant finds the language "the second data field identifies a plurality of different versions of the multimedia content to which the annotation corresponds" to appear in claim 10. The functionality of the second data field is to associate the first data field containing the annotation with the plurality of different versions of the multimedia content to which the annotation corresponds. Such is a useful, concrete and tangible result, as is described in MPEP 2106, entitled "Patentable Subject Matter - Computer-Related Inventions". This is discussed in more detail in subsection II(A), entitled "Identify and Understand Any Practical Application

Asserted for the Invention". This MPEP section also states that "Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection." Accordingly, in the event that the rejection is maintained, Applicant requests clarification of the rejection.

Thus, for at least these reasons, Applicant respectfully submits that claims 10-12 comply with 35 U.S.C. §101. Accordingly, Applicant respectfully requests that the §101 rejections be withdrawn.

### **35 U.S.C. § 103**

Claims 1-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "Synchronized Multimedia Integration Language (SMIL) 1.0 Specification", W3C Recommendation 15 June 1998, (hereinafter "W3C") in view of U.S. Patent No. 6,332,144 to deVries et al. (hereinafter "deVries"). Claims 13-20, 22 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over W3C in view of U.S. Patent No. 6,449,653 to Klemets et al. (hereinafter "Klemets"). Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over W3C and Klemets and further in view of "Media Weaver" by Sha Xin Wei (hereinafter "Wei"). Applicant respectfully submits that claims 1-23 are not unpatentable over W3C in view of deVries, Klemets and/or Wei and requests reconsideration.

In traversing the rejection, it is helpful to first review the teachings of the references. Accordingly, brief summaries of W3C, deVries, Klemets and Wei appear below.

W3C provides a specification for a "Synchronized Multimedia Integration Language" (Title). This language is intended to allow integration of "a set of independent multimedia objects into a synchronized multimedia presentation. Using SMIL, an author can

1. describe the temporal behavior of the presentation
2. describe the layout of the presentation on a screen
3. associate hyperlinks with media objects" (Abstract).

deVries describes a "Technique For Annotating Media" (Title), and teaches that "To annotate media, one or more particular times within a period defined by a start time and an end time of a media stream forming an item of audio or video media, are identified. The identified times are those at which content within the media stream corresponds to an annotation value. The annotation value is associated with the identified times to annotate the media." (Abstract).

Klemets includes teachings related to an "Interleaved Multiple Multimedia Stream For Synchronized Transmission Over A Computer Network" (Title).

Wei teaches "A Distributed Media Authoring System For Networked Scholarly Workspaces" (Title). Wei teaches that this provides "a software framework for composing distributed media in the context of university research and instruction. Authors may compose networked media, software tools and mediastreams, and can freely annotate media by media of any form using schema of their own design. Faculty and student authors compose distributed media using common Macintosh, World Wide Web and NeXTSTEP applications, supported by services from UNIX workstations." (Abstract).

The Office Action states (p. 3) that W3C discloses a system (p.26, ex. 4) for associating annotations, contained in the <text.../> tag, to the plurality of media streams, representing different versions of multimedia content ... as explained in the header of the example." In this example, <text .../> represents the multimedia content and is not an annotation (see, e.g., the Title of this section - "Choosing between content written for different screens"). Note that no other element is provided that could represent any other media content in this example. Note also that in the immediately preceding example, "<audio .../>" is the syntax, with "..." representing a specific audio source, such as: src="joe-audio-french" system-language ="fr". Ellipsis simply indicates that the argument pointing to the text source is arbitrary in this example.

The Office Action also states (p. 4) that W3C does however disclose that both the annotations and media are referenced by a URI (p. 19, "src"). The Office Action also states (p. 5) that W3C teaches a data field representing an annotation ...." Applicant respectfully disagrees. W3C is silent with respect to annotations.

The Office Action further states that deVries discloses that media and annotations can be stored on servers (Fig. 1B, 22 and 26). Combining such with the teachings of W3C fails to provide "an annotation database, coupled to the multimedia server, that stores a plurality of annotations, wherein each of the plurality of annotations is correlated with different versions of multimedia content contained in the plurality of media streams", as recited in claim 1, or any "second data field identifies a plurality of different versions of the multimedia content to which the annotation corresponds", as recited in claim 10.

In contrast, deVries teaches (col. 2, lines 10-13) that "According to the present invention, an item of audio or video media is annotated by identifying the particular time or times within the period defined by the start and end times of a media stream forming an item of media." There is no teaching, disclosure, suggestion or motivation in either W3C or deVries of any annotation being associated with multiple version of multimedia content.

Accordingly, combining the teachings of the references does not provide the invention as recited in claim 1 or claim 10. Additionally, there is no teaching or disclosure within the references to guide one of ordinary skill in selecting elements from the references or combining the selected elements.

Claim 13 recites "A method comprising: receiving a user request to create a new annotation; and associating the new annotation with a set of media streams, wherein the set of media streams is part of a plurality of media streams, and wherein each of the plurality of media streams is a different version of multimedia content", which is not taught, disclosed, suggested or motivated by the cited references. W3C is silent with respect to annotations. The word "annotation" does not appear anywhere in W3C. Modifying the teachings of W3C fails to provide the invention as recited in claim 13 and specifically fails to provide "associating the new annotation with a set of media streams", as recited in claim 13.

Claim 20 recites "A method comprising: receiving an indication of a version of media content being presented to a user; identifying a collection of annotations corresponding to the media content, each annotation corresponding to a plurality of different versions of the media content; and providing selected

annotations from the collection of annotations to the client computer for presentation to the user", which is not taught, disclosed, suggested or motivated by the cited references. W3C and the Office Action are silent with respect to annotations that each correspond to a plurality of different version of media content, as recited in claim 20.

The unpatentability rejections fail to meet the standards set forth in the MPEP for establishing a prima facie case of unpatentability. These are set forth in MPEP §2142, entitled "Legal Concept of Prima Facie Obviousness" (see also MPEP §706.02(j)).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The references fail to teach or disclose the elements recited in the claims. Accordingly, the references cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the references. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the references fail to provide all of the features recited in Applicant's claims, the third prong of the test is not met. As a result, there cannot



be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claim.

Accordingly, the unpatentability rejections fail all of the criteria for establishing a prima facie case of obviousness as set forth in the MPEP.

Inasmuch as there is no guidance within the references to identify which teachings should be selected or how they should be combined, it appears that the rejection is based on an improper "obvious to try" standard. Such is described in more detail below with reference to MPEP §2145(X)(B). This MPEP section states that:

The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted).

No indication as to which parameters are critical and no direction as to which of many possible choices is likely to be successful has been identified in the references relied upon.

Dependent claims 2-9, 11, 12, 14-19 and 21-23 are allowable as depending from an allowable base claims and for their own recited features which are neither shown nor suggested by the prior art. For at least these reasons, Applicant respectfully requests that the §103 rejections of claims 1-23 be withdrawn, and that claims 1-23 be allowed.

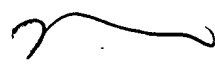
### **Conclusion**

Claims 1-27 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: Mar 31, 2003

By: \_\_\_\_\_

  
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## **Version of Claims with Markings to Show Changes Made**

### **In the Specification:**

Please amend the paragraph on p. 22 spanning lines 17-20 as shown below:

Annotation database 206 includes [a] fields 212, 214, and 216 that specify common characteristics of all annotation entries of database 206 or an annotation collection 208 or 210. Alternatively, fields 212-216 can be included redundantly in each annotation entry 180.

Please amend the paragraph on p. 23 spanning lines 17-20 as shown below:

Selection of an exit or “X” button 242 causes interface 152 to terminate display of the toolbar 240. A server identifier 244 identifies the annotation server with which client 15 is currently configured to communicate (annotation server 10 of Fig. 1[.] in the illustrated embodiment).

### **In the Claims:**

1. (Amended) A system comprising:

a multimedia server having access to a plurality of media streams that represent different versions of multimedia content;

an annotation database, coupled to the multimedia server, that stores a plurality of annotations, wherein each of the plurality of annotations [corresponds to each of the plurality of] is correlated with different versions of multimedia content contained in the plurality of media streams; and

an annotation server, coupled to the annotation database, to manage storage and retrieval of the plurality of annotations.

Claims 24-27 have been added.

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